

REMARKS

Claims 1-68 are pending. Claims 1-17, 19, 24-28, 30, 35-64, and 67-68 are cancelled without prejudice. Claims 18, 20-23, 29, 31-34, 65, and 66 will therefore be pending upon entry of the proposed amendments.

Applicants note that claims 23 and 33 are deemed withdrawn from consideration.

Applicants submit that both claims 23 and 33 read on the elected species and therefore are drawn to elected subject matter. Applicants respectfully request that claims 23 and 33 be examined in concert with remaining pending claims 18, 20-23, 29, 31-34, 65, and 66.

Claim 18 has been amended as follows. Applicants have amended the definitions of X, Y, and Z to comport in scope with the present restriction group. The definition of Z has also been amended to incorporate limitations of the second proviso recited at the end of claim 18 (i.e., "... and that when Y is a bond, either X is -NH-alkyl-, -NH-alkenyl-, -N(alkyl)-alkyl-, -N(alkyl)-alkenyl-, -O-alkyl-, -O-alkenyl-, -S-alkyl-, or -S-alkenyl-; or Z is substituted with halo, sulfonic acid, -O-sulfonic acid, alkylsulfinyl, or alkylsulfonyl, or is alkenyl").

In short, claim 18 requires that variable Z is either (1) alkyl, alkynyl, cycloalkyl, heterocycloalkyl, cycloalkenyl, heterocycloalkenyl, aryl, heteroaryl, aralkyl, or heteroaralkyl, each of which must be substituted with -O-sulfonic acid, alkylsulfinyl, alkylsulfonyl, carboxyl or alkyloxycarbonyl; or (2) alkenyl that is optionally substituted with hydroxy, alkoxy, amino, halo, sulfonic acid, -O-sulfonic acid, carboxyl, oxo, alkyloxycarbonyl, alkylcarbonyloxy, alkylaminocarbonyl, alkylcarbonylamino, alkylcarbonyl, alkylsulfinyl, alkylsulfonyl, or alkylthio. As such, claim 18 as currently amended excludes halo as a permissible substituent for all Z groups except for alkenyl. Support for these amendments can be found throughout the Specification, e.g., at page 10, line 1; and in claims 18, 33, and 34 as originally filed.

Claim 29 has been amended to be consistent with the amendments to claim 18 from which it now depends. Claim 34 has been amended to comport in scope with the present restriction group. Claims 65 and 66 have been amended as described for claims 18 and 34, respectively.

No new matter has been introduced by these amendments.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 34 and 66 are rejected because “they lack a period” (Office Action, page 3). This rejection is moot in view of the amendments to claims 34 and 66.

Rejections under 35 U.S.C. 102(b)

Claims 18-22, 28, 29, 31, 32, and 65 are rejected as being anticipated by Kihiri et al., *Steroids 1992, 57, 193* (Kihiri). According to the Office Action:

Kihiri et al. teach several analogs of bile acids such as 23-iodo-24-nor-5 $\beta$ -cholane-3 $\alpha$ , 6  $\alpha$  -diol and 24-iodo-5 $\beta$ -cholane-3 $\alpha$ , 6  $\alpha$  -diol and ethanolic compositions thereof (see entire article, especially page 195, compounds 4e and 4h) (Office Action, page 4).

The rejection of claims 19 and 28 are moot in view of their cancellation.

Kihiri compound 4e contains the group –CH(CH<sub>3</sub>)CH<sub>2</sub>CH<sub>2</sub>I, which corresponds to R<sup>17</sup> in the formula delineated in claim 18. Likewise, Kihiri compound 4h contains the group –CH(CH<sub>3</sub>)CH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>I, which corresponds to R<sup>17</sup> in the formula delineated in claim 18. R<sup>17</sup> is further defined in claim 18 as “-X-Y-Z-.” Accordingly, each of the groups –CH(CH<sub>3</sub>)CH<sub>2</sub>CH<sub>2</sub>I and –CH(CH<sub>3</sub>) CH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>I in the Kihiri compounds corresponds to an R<sup>17</sup> substituent in which X is alkyl, Y is a bond, and Z is halo-substituted alkyl.

However, independent claims 18 and 65 as currently amended exclude halo as a permissible substituent for Z when Z is an alkyl group. As such, the compounds disclosed in Kihiri fall outside of the scope of claim 18 as currently amended.

Applicants submit that Kihiri does not anticipate claims 18 and 65 as currently amended because Kihiri does not teach every element of claim 18 and 65 as currently amended. Since claims 20-22, 29, 31, 32 depend from claim 18, they also are not anticipated by Kihiri. Applicants respectfully request withdrawal of the rejection and request that the rejection not be applied to claims 23 and 33.

Claims 18-22, 28, 29, 31, 32, and 65 are rejected as being anticipated by Huang et al., *Journal of Fluorine Chemistry* 1989 43, 305 (Huang). According to the Office Action:

Huang et al. teach the production of fluorine-containing steroids such as 20-(8-chloro-3,3,4,4,5,5,6,6-octafluorohexyl)-5 $\beta$ -pregnane-3 $\alpha$ ,6  $\alpha$ -diol and 20-(6-chloro-3,3,4,4,5,5,6,6,7,7,8,8-dodecafluoroctyl)-5 $\beta$ -pregnane-3 $\alpha$ ,6  $\alpha$ -diol (see the entire article, especially page 307 and 313, compounds 4a-4e) (Office Action, page 4).

The rejection of claims 19 and 28 are moot in view of their cancellation.

Each of the Huang compounds 4a-4e contains the group  $-\text{CH}(\text{CH}_3)\text{CH}_2\text{CH}_2\text{R}_f$  ( $\text{R}_f$  is C<sub>4</sub>-C<sub>6</sub> perhaloalkyl), which corresponds to R<sup>17</sup> in the formula delineated in claim 18. R<sup>17</sup> is further defined in claim 18 as “-X-Y-Z-.” Accordingly, each of the groups  $-\text{CH}(\text{CH}_3)\text{CH}_2\text{CH}_2\text{R}_f$  in the Huang compounds corresponds to an R<sup>17</sup> substituent in which X is alkyl, Y is a bond, and Z is halo-substituted alkyl.

However, independent claims 18 and 65 as currently amended exclude halo as a permissible substituent for Z when Z is an alkyl group. As such, the compounds disclosed in Huang fall outside of the scope of claim 18 as currently amended.

Applicants submit that Huang does not anticipate claims 18 and 65 as currently amended because Huang does not teach every element of claim 18 and 65 as currently amended. Since claims 20-22, 29, 31, 32 depend from claim 18, they also are not anticipated by Huang.

Applicants respectfully request withdrawal of the rejection and request that the rejection not be applied to claims 23 and 33.

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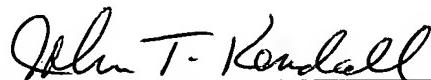
### CONCLUSION

Applicants submit that all claims are in condition for allowance.

Enclosed is a \$60 check for the One Month Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 10634-002002.

Respectfully submitted,

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